

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-15 are pending in this application. Claims 1 and 6-8 are amended by the present amendment. No new matter is added.

In the outstanding Official Action, Claims 1-2, 6-10, and 12-15 were rejected under 35 U.S.C. §103(a) as unpatentable over Takano (U.S. Patent No. 4,581,657) in view of Allis et al. (U.S. Patent No. 4,318,135, hereinafter "Allis"). Claims 3-5 and 11 were rejected under 35 U.S.C. §103(a) as unpatentable over Takano in view of Allis and further in view of Miyahara et al. (U.S. Patent No. 6,439,299, hereinafter "Miyahara").

With regard to the rejection of Claim 1 under 35 U.S.C. §103(a) as unpatentable over Takano in view of Allis, that rejection is respectfully traversed.

Amended Claim 1 recites in part:

an image focusing lens holding member comprising a surface;

an intermediate holding member configured to hold a solid state image forming device onto the image focusing lens holding member, the intermediate holding member comprising a surface facing the surface of the image focusing lens holding member; and

at least one projecting portion formed on one of the surfaces of the image focusing lens holding member and the intermediate holding member, the at least one projection portion comprising a surface contacting through an adhesive material the other one of the surfaces of the intermediate holding member and the image focusing lens holding member,

wherein a space configured to receive a tool inserted therein, is formed between the intermediate holding member and the image focusing lens holding member, wherein said intermediate holding member and said image focusing lens holding member which are fixed by the adhesive material are separated by the tool.

The outstanding Office Action cited *lens* 9 of Takano as “an image focusing lens holding member.”¹ Takano describes that lens 9 may be directly adhered to substrate 6 of Takano, which was cited by the outstanding Office action as “an intermediate holding member.”² Clearly, lens 9 of Takano cannot be both a lens *and* a lens holding member. Thus, as Takano describes that lens 9 is directly adhered to substrate 6, and Takano does not teach that any other structure may be interposed between lens 9 and substrate 6 to hold lens 9 and be adhered to substrate 6, Takano does not teach or suggest “at least one projection portion comprising a surface contacting through an adhesive material the other one of the surfaces of the intermediate holding member and the image focusing lens holding member,” as recited in amended Claim 1. As Allis also fails to teach or suggest any of these features, and no part of Allis has been cited as describing any of the above features, amended Claim 1 is patentable over Takano in view of Allis.

Further, Takano does not teach or suggest “said intermediate holding member and said image focusing lens holding member *which are fixed by the adhesive material* are separated by the tool.” As noted above, Takano at best describes that lens 9 and substrate 6 are adhered to each other, and does not teach or suggest any space between lens 9 and substrate 6. The outstanding Office Action cited Allis as describing “a space configured to receive a tool inserted therein, is formed between the intermediate holding member and the image focusing lens holding member.”³ However, Allis describes that each array support assembly 101 is attached to the scan carriage frame 52 by means of a pair of externally threaded screw members 152, 154 and cooperating locking screws 160.⁴ Accordingly, neither Takano nor Allis teach or suggest “said intermediate holding member and said image

¹See the outstanding Office Action at page 3, lines 6-8.

²See the outstanding Office Action at page 3, lines 8-9.

³See the outstanding Office Action at page 4, lines 1-4.

⁴See Allis, column 5, lines 28-33 and Figure 7.

focusing lens holding member *which are fixed by the adhesive material* are separated by the tool.”

Moreover, Takano describes that lens 9 is inserted into aperture 6B of substrate 6, and when lens 9 is in a desired location, lens 9 is fixed to substrate 6 by an adhesive or screws.⁵ Accordingly, to modify the device of Takano as suggested by the outstanding Office Action by inserting a space between lens 9 and substrate 6 would require a different means of fixing the lens to the substrate 6, or would prevent the fixing of lens 9 to substrate 6. It is respectfully noted that if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (C.C.P.A. 1959). See also MPEP §2143.01. As the presently proposed modification would change the principle of operation of the device described by Takano, there is no suggestion or motivation to make the proposed combination.

Consequently, as Takano and Allis do not teach or suggest each and every element of Claim 1, and there is no suggestion or motivation to combine the cited references, Claim 1 (and Claims 2-5 dependent therefrom) is patentable over Takano and Allis.

As independent Claims 6 and 7 recite similar elements to Claim 1, Claims 6 and 7 are also patentable over Takano and Allis.

Amended Claim 8 recites in part, “a lens holding member configured to hold a lens.” As noted above with respect to Claim 1, Takano does not describe “a lens holding member,” but in fact describes a lens 9 that is fixed to substrate 6. Thus, neither Takano nor Allis teach or suggest “a lens holding member” or “at least one projection formed on a surface of one of the lens holding member and the intermediate holding member, the projection configured to contact a surface of the other one of the intermediate holding member and the lens holding

⁵See Takano, column 3, line 67 to column 4, line 6.

member” as recited in Claim 8. Consequently, Claim 8 (and Claims 9-15 dependent therefrom) is patentable over Takano in view of Allis.

With regard to the rejection of Claims 3-5 and 11 as unpatentable over Takano and Allis in view of Miyahara, Claims 3-5 and 11 depend from Claims 1 and 8, and thus are believed to be patentable for at least the reasons described above with respect to Claim 1. Further, Miyahara does not cure any of the above-noted deficiencies of Takano and Allis. Accordingly, Claims 3-5 and 11 are patentable over Takano and Allis in view of Miyahara.

Accordingly, in view of the present amendment, no further issues are believed to be outstanding and the present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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